REMARKS

Claims 83 through 96 were pending in the present application when last examined and were rejected. No amendments are being entered herein and no new matter is being added. Claims 83 through 96 remain pending in the present application.

Objection and Rejections under 35 U.S.C. § 112

In item 2 on pages 2-3, of the Office Action, the Examiner objected to the specification under 35 U.S.C. § 112, first paragraph, "as failing to adequately teach how to make and use the invention. Applicants respectfully traverse.

The Examiner asserts that the disclosure is inadequate in that "Applicant did not teach the details of how the smart phone [or] a television settop box provided workspace data including the differences as claimed in claims 86 and 93" (page 2) Specifically, the Examiner asserts that "It would [have taken] undue experimentation for one of ordinary skill in the [networking] art (pages 2 and 3) to determine the details of the smart phone and a television settop box" because these "have limited memory resources", "applications that are suitable for desktop computers are not suitable for" and "have to be optimized specifically for these limited resource devices" and the "Present disclosure lacks such optimization details" (emphasis added). In support thereof, the Examiner asserts, as a contrastingly *proper* disclosure example, U.S. Patent No. 6,212,529 statement merely because it states: "If the remote database is located on a handheld computer, R translator manages the memory of the handheld device by limiting the size of the database stored on the handheld computer" (page 2 of the Action). The Examiner further, therefore, objects to the specification and rejects instant claims 85 and 96.

Applicants respectfully object to the Examiner's unsupported assertions and disagree with the Examiner's (1) basis for so asserting, determination of the relevant art, and (3) conclusions drawn therefrom.

First, the Examiner has offered NO evidence whatsoever regarding the level of skill in ANY art, let alone the art or arts that should properly be considered with regard to the present invention. Given, however, that the Examiner points to memory size differences and points to a patent that essentially states storing an amount of data corresponding to available memory and

that "[a] patent need not teach, and preferably omits, what is well known in the art" *In re Buchner*, 929 F.2d 660, 661, 18 USPQ 1331, 1332 (Fed. Cir. 1991), the Examiner's basis is apparently that considering the amount of available memory in a device and adjusting accordingly was not known by one of ordinary skill in the art.

In contradiction thereof, Applicants offer that the very first principal factor to be considered by any engineer in considering any programming project in the entry level engineering textbook published in 1980, *Microcomputers for Engineers and Scientists*, Gibson and Liu, Prentice-Hall, Inc., which reference is submitted herewith, is "1. Memory space required for the program" (page 216, section 7-6). Section 7-6-1 ("Memory Space") further begins by stating that "Memory space may be at a premium in small systems", among various other references therein. Therefore, considering that the prior applications that the present Application incorporates date only to the 1990s, clearly the Examiner's very basis is incorrect. Rather, assuring that available memory space is accommodated was clearly WELL known by those of ordinary skill in essentially ALL computing arts at the time of the invention. (See also section 13-2 ("multiprogramming and memory management") on page 384-385.)

Applicants further respectfully submit that the Examiner's unsubstantiated basis regarding applications is also unfortunately erroneous. Turning first to section 12-1 of the same text (on page 358), cross assemblers were also WELL known and well within the ordinary skill of those in essentially ALL computing arts at the time of the invention. (See also page 372.) Therefore, one skilled in the art would be aware of and further expect that versions of the same application should be convertible to different devices. Additionally, cell phones have existed since 1973 (*Cell phone inventor 30 years after*, CNET News.com, 4/7/2003, submitted herewith), the palm pilot was released in 1996 (*Historical Timeline*, Palm - Company - Company History, first page, submitted herewith), one smart phone embodiment might include a combination of the two, and that Windows CE was ALREADY in widespread use in 1997 (*Buyers Alert*, ZDNET News, 9/30/1997 submitted herewith). Therefore, since cross-compiling, an operating system providing for similar applications on different devices (including a smart phone embodiment) and a smart phone embodiment were well known at the time of the invention, then clearly the invention as claimed is sufficiently supported by the present Application in combination with ordinary skill. Applicants further assert the very same arguments with regard to television settop

boxes, which are essentially computers, and the design of which the undersigned Attorney for Applicants was involved in the 1980s and well before the priority date of the instant Application.

Therefore, withdrawal of the objection/rejection and early allowance of the pending claims is respectfully solicited for at least the foregoing reasons.

Applicants further respectfully disagree with the Examiner's choice of the relevant art of Networking as improper. Applicants remind the Examiner that "The relative skill in the art refers to the skill of those in the art in relation to the subject matter to which the claimed invention pertains... Where different arts are involved..., the specification is enabling if it enables persons skilled in each art to carry out the aspects of the invention applicable to their specialty. *In re Naquin*, 398 F.2d 863, 866, 158 USPQ 317, 319 (CCPA 1968). Further, the Board has stated with regard to a claimed invention involving an electronic computer and fuel injection, "appellants' disclosure must be upheld sufficient if it would enable a person skilled in the electronic computer art, in cooperation with a person skilled in the fuel injection art, to make and use appellants' invention". *Ex parte Zechnall*, 194, USPQ 461 (Bd. App. 1973).

As in *Ex parte Zechnall*, the present invention involves at least computing devices, including smart phones and settop boxes (see MPEP 2164.01- 2164.04), and networking, as is evidenced by the specification as well as the Examiner's instant objection and rejection (see above). Applicants respectfully submit that the limiting of the relevant art to networking is arbitrary and improper. Applicants further submit that the instant specification is clearly sufficient under section 112 in view of the knowledge of one skilled in the computing arts generally or the specific computing device arts, let alone the coordination of ordinary skill in such arts as combined with networking, at the time of the invention generally and particularly in view of the foregoing.

Therefore, withdrawal of the objection and rejections and early allowance of the pending claims are respectfully solicited for at least the foregoing reasons.

Applicants still further respectfully submit that the Examiner has improperly failed to provide any basis whatsoever for asserting that the instant specification is somehow self-limiting to desktop computing. Rather, the Examiner's rejection itself admits of the applicability of the examples of the specification to at least computing and/or networking.

Therefore, withdrawal of the objection and rejections and early allowance of the pending claims are respectfully solicited for at least the foregoing reason.

Applicants also respectfully remind the Examiner that not all experimentation is properly considered undue. For example, "The test is not merely quantitative, since a considerable amount of experimentation is permissible, if it is merely routine, or if the specification... provides a reasonable amount of guidance with respect to the direction in which experimentation should proceed." *In re Woods*, 858 F.2d 731, 737, 8 USPQ 2d 1400, 1404 (Fed. Cir. 1988) (emphasis added). Thus, even assuming arguendo that some, and even a large amount of experimentation would be required, the Examiner has improperly failed to show why such amount is undue. Applicants further submit, particularly though not necessarily in view of the references submitted herewith, that any experimentation that might be required to ascertain memory size, adjust or convert applications, and so on, would merely be routine. Applicants also submit that one of ordinary skill in the *properly* delineated arts need only follow the disclosure, particularly though not necessarily in view of ordinary skill at the time of the invention.

Therefore, withdrawal of the objection and rejections and early allowance of the pending claims are respectfully solicited for at least the foregoing reasons.

Regarding the remaining rejected claims and objection to the specification, the Examiner apparently suggests that bookmarks are unique, in and of themselves. This is not contended. Rather, it is the unique system/processing as applied to bookmarks in accordance with the recited embodiments that is claimed. Rather, mere hyperlinks are WELL known, as are component operations that can be performed on data such as hyperlinks in accordance with teachings of the specification. The discussion on page 173 of the afore-mentioned *Microcomputers for engineers and scientists*, for example, explains how hyperlinks or other workspace data might be compared in accordance with the instant specification and subject claims.

Applicants further respectfully submit the same arguments for bookmarking as were presented above with regard to smart phones and settop boxes.

Additionally, Applicants submit generally with regard to the objection(s) and rejections that the Examiner has failed to consider, let alone set forth evidence that none of the prior

applications the present specification incorporates by reference includes the disclosure that the Examiner finds to be deficient in the present Specification. The Examiner is reminded that "The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed" (see MPEP 2163.07(b)). Applicants submit that the whole of the present application, which therefore includes such disclosure as incorporated by reference, is indeed sufficient under 35 USC § 112.

Accordingly, withdrawal of the objection and rejections and early allowance of the pending claims are respectfully solicited for at least the foregoing reasons.

Rejections under 35 U.S.C. § 103(a)

In items 4 through 13 that begin on page 3 of the Office Action, the Examiner rejected claims 83 through 96 under 35 U.S.C. § 103(a) as being unpatentable over US Patent Number 6,343,313 to Salesky et al (hereinafter "Salesky") in view of well known features of the networking art. Applicants respectfully traverse.

The Examiner asserts in item 7 that Salesky taught the invention substantially as claimed including a conferencing system comprising: a) means for storing first workspace data on a first device (at 7:35 et seq.), b) means for storing second workspace data on a second device (8:3 et seq.); c) means for determining differences between the first workspace data and the second workspace data (7:38-65); d) means for storing the differences at a global server (7:66-67); and e) means for sending the differences from global server to the second device (8:1 et seq.). Applicants respectfully disagree.

Claim 83 recites:

83. (Once Amended) A method for synchronizing workspace data, comprising:
    storing first workspace data on a first device;
    storing second workspace data on a second device;

determining differences between the first workspace data and the second

workspace data;

storing the differences at a global server; and

sending the differences from the global server to the second device.

Applicants respectfully submit that claim 83 is not taught, suggested or otherwise rendered obvious by Salesky at least by reciting "determining differences between the first workspace data and the second workspace data" of the recited first and second devices respectfully (emphasis added), "storing the differences at a global server" and "sending the differences from the global server to the second device".

As the Examiner points out, Salesky teaches a video conferencing system. Specifically, Salesky teaches that its system "transports... those [arbitrary streams of data] where intermediate updates can be dropped if they are obsoleted by later arriving data updates" (Salesky Abstract). Specifically, "Conferencing software on the presenter client computer captures a portion of the screen display of the presenter client and sends the captured region... to the conference server" (col. 2, lines 28-33), which current view is obtained by the attendee client (col. 2, lines 40-41), or in a simple embodiment, "the entire screen of the presenter is shown to all of the attendees" (col. 2, lines 54-58). There is not even the consideration of data of any kind that might be stored on a second device, let alone any consideration of the "determining differences" between ANY data stored on a first device and a second device. There is further no consideration of storing only the "differences" at "a global server" or "sending" only "the differences from the global server to" a "second device", such as in the instant recited embodiment of claim 83. In fact, the operation in Salesky REQUIRES that the entire screen or a portion thereof be captured and sent to attendee clients for processing, which is wholly contrary to the embodiment recited by claim 83.

Therefore, even assuming arguendo that Salesky might be considered to cover a similar art and further to provide some form of "synchronizing" as the Examiner suggests, Salesky would necessarily conduct such synchronizing in contravention of the recited embodiment of claim 83, and to suggest otherwise would require impermissible hindsight. Respectfully, Salesky quite simply teaches sending ALL of a first device data to a second device, which data is captured from the first device display, while the present invention at least contrastingly DETERMINES DIFFERENCES between first and second device workspace data and stores at

the global server and sends to the second device only the DIFFERENCES. The present invention is therefore unobvious over and far more efficient than Salesky for at least this reason.

Claim 90 is patentable over Salesky by reciting:

90. (Once Amended) A system for synchronizing workspace data, comprising:

means for storing first workspace data on a first device;

means for storing second workspace data on a second device;

means for determining differences between the first workspace data and the second workspace data;

means for storing the differences at a global server; and

means for sending the differences from the global server to the second device.

Respecting claim 90, Salesky NECESSARILY fails to provide at least "means for determining differences between first workspace data" stored on a first device and "second workspace data" stored on a second device, means for storing the differences at a global server", and/or "means for sending the differences from the global server to the second device". Specifically, Salesky does not determine, store and send differences; nor does Salesky provide means for doing so. To suggest otherwise would further require impermissible hindsight, since the system of Salesky is NECESSARILY configured to provide for transmission of a captured first device screen or a portion thereof according to SALESKY. In other words, and with all due respect, Salesky disagrees directly with the Examiner.

Accordingly, Applicant respectfully submits that claims 83 and 90 are patentable over Salesky irregardless of the combination of Salesky with well known features of the networking art (or any other art for that matter) for at least the foregoing reasons. The remaining claims are dependent claims depending from claims 83 and 90 and are patentable over Salesky and well

known features of the networking art (or any other art for that matter) for at least the same reasons as set forth respecting claims 83 and 90.
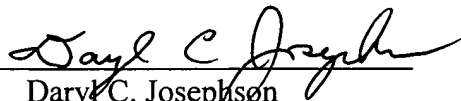
The Examiner in item 8 additionally points to other references, suggesting that these might be asserted against the present Application, but does not assert such references. The Examiner does, however, point out that US Patent 5,974,238 to Compaq "looks interesting". Applicants nevertheless respectfully remind the Examiner that such reference is dated in 1999, which is well after the priority date of the present Application. Such reference is therefore clearly NOT prior art to the present Application.

Accordingly, Applicants respectfully request withdrawal of the rejection and timely allowance of claims 83-96 for at least the foregoing reasons.

If the Examiner has any questions or needs any additional information, the Examiner is invited to telephone the undersigned attorney or Applicants further attorney, Marc Sockol, Esq., at (650) 856-6500.

Respectfully submitted,

Dated: July 1, 2003   By _____
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